

REMARKS

The Office has rejected claims 14, 15, 17-19, 21-25, and 27 under 35 USC 102(e) as anticipated by Chen. Applicants respectfully traverse this rejection. The Office has rejected claims 16 and 20 under 35 USC 103(a) as unpatentable over Chen in view of Conley. Applicants have amended independent claims 14, 18, and 21 to further distinguish over the cited references. Applicants otherwise respectfully traverse the Office's rejections for failing to give patentable significance to specific claimed elements and/or for inappropriately stretching the teachings of Chen and Conley beyond what is permitted by established law.

Chen discloses an email system for sending and receiving emails on behalf of subscribers of the email system. In order to defray the cost of offering more services to its subscribers, the email system inserts advertisements into email messages addressed to its subscribers. The advertisements may be based upon subscriber preferences stored by the email system in subscriber profiles. The advertisements may contain HTML links.

Conley discloses an enhanced browser system. One enhancement is an email grabbing program which grabs

information from emails viewed by a user of the browser and stores the information in an email database for later access by the user of the browser.

With respect to claim 14, the references fail to disclose

...

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;

...

displaying the e-mail message on the second client computer, wherein when the email message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display within the e-mail message on the second client computer.

Chen discloses that advertisements in an email may include HTML links. The advertisements are already part of the email, so the HTML links cannot serve to retrieve advertisements from a database for display within the email message when the email message is first displayed.

With respect to independent claim 18, Chen fails to disclose

storing an identifier for an entity selected by an e-mail user;

...

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;

...

...

retrieving at least one of the plurality of advertisements retrievably stored in the database for display within the e-mail message on the second client computer; and

...

As noted above, Chen fails to disclose retrieval of advertisements from a database when an email message is displayed, as the advertisements are already part of the email message of Chen.

Chen further fails to disclose storing an identifier for an entity selected by an email user, i.e., the sender of the email. The teachings of Chen are focused on preferences of

email recipients, not preferences of email senders.

With respect to independent claim 21, Chen fails to disclose

...

appending a sub-message associated with an advertisement to the e-mail at a host server while the e-mail is enroute to the recipient based up preferences of the e-mail user;

...

accounting with the host server for advertising revenue in response to the receipt of the return communication.

As noted above, Chen fails to disclose retrieval of advertisements from a database when an email message is displayed, as the advertisements are already part of the email message of Chen.

Chen further fails to disclose appending a sub-message associated with an advertisement based up preferences of the e-mail user, i.e., the sender of the email. The teachings of Chen are focused on preferences of email recipients, not preferences of email senders.

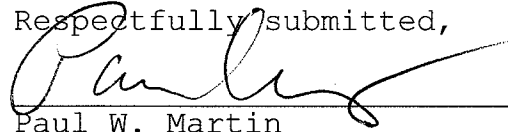
Chen further fails to disclose the transmitting and

accounting steps. While Chen discloses payment of money from advertisers to email system operators in return for inclusion of advertisements in emails to recipients, Chen fails to disclose an accounting triggered by a response from a recipient computer that has displayed an email containing an advertisement.

With respect to claims 16 and 20, the arguments above involving Chen apply as well. Like Chen, the relevant teachings of Conley are more limited than suggested by the Office. The mail grabbing program is a tool for the convenience of the browser operator which allows the browser operator to easily find email addresses and information about people associated with the email addresses *from a local email database*. Conley provides no express or implied teaching that would suggest that the local email database is searchable by a remote host server for the purpose of delivering advertisements to the browser operator.

Applicant respectfully requests that the pending claims
be allowed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Paul W. Martin", written over a horizontal line.

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